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TO: Examiner Matthew S. Gart
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FROM: Robert H. Frantz
Franklin Gray Patents, LLC
Tel: 405-812-5613
Fax: 405-440-2465

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REPLY BRIEF

In re the Application of:

Leland James Wiesehuegel	)	
Serial Number: 09/801,613	)	Group: 3625
Docket Number: AUS920010024US1	)	Examiner: Matthew S. Gart
Filed on: 03/08/2001	)	
For: "Read-only User Access for Web Based Auction"	)	

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Robert H. Frantz, Reg. No. 42,553

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P.O. BOX 23324, OKLAHOMA CITY, OK 73123-2334
TEL.: 405-812-5613 FAX.: 405-440-2465
RFRANTZ@FRANKLINGRAY.COM WWW.FRANKLINGRAY.COM

In the United States Patent and Trademark Office

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REPLY BRIEF

Examiner's Position Regarding Grouping of Claims

In the Examiner's Answer, dated June 6, 2005, it was stated that the appellant's brief was not in compliance with 37 CFR §1.192(c)(7) with respect to identifying which claims stand or fall together. This summary of the current rules is incorrect.

Effective October 1, 2004, the rules for appeal from final rejections were modified, as summarized by the Consolidated Patent Rules, published online at:

http://www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf

According to these revised rules, 37 CFR §1.192 is now "reserved", and 37 CFR §41.37 sets forth the contents of an Appeal Brief. The appellant may choose to argue against rejections by groups of claims, and the Board may decide the appeal based upon groups of claims as argued by the appellant, but no provision is made for the Examiner to make a statement regarding the grouping of claims and their standing or falling together. Title 37 CFR §41.37(c)(1) states:

> ... For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.

> Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. ...

Appellant has properly argued claims 1, 9 and 17 together, and has argued claims 2 - 5, 10 - 13, and 22 - 23, as indicated by the subheadings in the Appeal Brief.

"Contract" versus "Acknowledging Specific Conditions"

In the Examiner's Answer on Page 4, it has been argued that the phrase in Goodwin's disclosure paragraph [0111] regarding "bidders may be required to sign on and/or acknowledge specific conditions before receiving information" establishes a pre-existing contract between the offeror and the guest.

A key consideration of this argument is whether or not this statement by Goodwin reasonably constitutes disclosure of a previously established binding *contract*, compared to our description and claim of an actual "contract".

Appellant submits that Goodwin's term "sign on" is used in the online computing context, synonymous to "logging on", such as supplying a username and password. Goodwin's disclosure is silent as to any acts of affixing of a signature to a paper or contract, such a "signing on" a "dotted line" of an agreement or contract.

To hold that Goodwin's August 10, 2001, disclosure implies that a binding contract can be consummated by an online "sign on" process or simple "acknowledgment of specific conditions" is contrary to the legal conditions of online commerce of the time. For example, electronic signatures as binding legal signatures were established on a US national basis by the Electronic Signatures in Global and National Commerce Act (E-SIGN), which went into effect October 1, 2000, prior to Goodwin's disclosure. According to the Federal Trade Commission (source: http://www.ftc.gov/os/2001/06/esign7.htm):

> Careful to preserve the underlying consumer protection laws governing consumers' rights to receive certain information in writing, Congress

> imposed special requirements on businesses that want to use electronic records or signatures in consumer transactions. Section 101(c)(1) of the Act provides that information required by law to be in writing can be made available electronically to a consumer only if he or she affirmatively consents to receive the information electronically, and the business clearly and conspicuously discloses specified information to the consumer before obtaining his or her consent.
>
> Moreover, Section 101(c)(1)(C)(ii) states that a consumer's consent to receive electronic records is valid only if the consumer "consents electronically or confirms his or her consent electronically, in a manner that reasonably demonstrates that the consumer can access information in the electronic form that will be used to provide the information that is the subject of the consent."

Prior to enactment of E-SIGN, most States had various but specific requirements of process, notification, and records retention in order for an online user agreement to be held as a valid, binding contract.

However, the very existence of laws such as E-SIGN and various state laws governing electronic signatures implies that not all electronic agreements are binding contracts, and more specifically, only certain electronic transactions meeting certain criteria result in binding contracts. Therefore, Appellant submits that it has been the presumption under the law that an online agreement is not a contract unless it meets these types of specific conditions.

Goodwin is silent as to such steps or processes to establish a binding contract to meet such "special requirements" such as those set forth in E-SIGN, for example. Goodwin is also silent regarding the pre-existence of a paper contract (e.g. a traditional contract).

In our disclosure, we specifically discussed "Reseller Master Agreements" ("RMA") as being "contracts". RMAs are well known in business, and are traditionally paper. Certainly, the term connotes a binding contract which could be made available in paper form, if not in paper form by default.

Because Goodwin's electronic "sign on" or "acknowledgment of specific conditions" is improperly interpreted in view of our disclosure as disclosing such requirements to establish a contract "in a manner which prevents a guest auction participant from modifying the entitlement schema", as we have claimed, Appellant requests reversal of all final rejections of claims 1, 9

and 17, and of claims 2 - 5, 10 - 13, and 22 - 23. Appellant maintains the separate arguments for claims 1, 9 and 17, and for claims 2 - 5, 10 - 13, and 22 - 23, as set forth in the Appeal Brief, thus preserving the separate groups of claims for consideration by the Board.

Summary

For the foregoing reasons, and for the reasons previously discussed in Appellant's Appeal Brief, it is submitted that the rejections of Claims 1 - 23 were erroneous, and allowance of these claims is respectfully requested.

Respectfully Submitted,

Robert Frantz

Agent for Applicant(s)
Robert H. Frantz, Reg. No. 42,553
Tel: (405) 812-5613

Franklin Gray Patents, LLC
P.O. Box 23324
Oklahoma City, OK 73127
Tel: 405-812-5613
Fax: 405-440-2465